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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,404	10/16/2001	Michiaki Yokoyama	1341.1112	3181
21171	7590	06/01/2005	EXAMINER	
STAAS & HALSEY LLP			MCALLISTER, STEVEN B	
SUITE 700			ART UNIT	
1201 NEW YORK AVENUE, N.W.			PAPER NUMBER	
WASHINGTON, DC 20005			3627	

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,404

Applicant(s)

YOKOYAMA ET AL.

Examiner

Steven B. McAllister

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I, claims 1-5 in the reply filed on 3/10/2005 is acknowledged.

Claims 6-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/10/2005.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 5 are unclear because they recite transmitting a third email "when the person is regarded as another existing customer" because it is not clear what this means.

Claims 1 and 5 are unclear because they refer to a "customer-to-be" and a "person". It is not clear whether these are intended to recite the same entity or different entities.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 5 is rejected under 35 U.S.C. 102(e) as being anticipated by Mullaney (2001/0037283).

Mullaney discloses a computer readable medium capable of storing instruction affecting all claimed steps. (it is noted that “for storing instructions” is interpreted as intended use only and that all further recitations only further elaborate on the instructions and place no further limitations on the computer readable medium).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullaney in view of Graham et al (2002/0098891).

As to claims 1 and 5, Mullaney shows transmitting to a first terminal of an existing customer a first email requesting an introduction of new customers, based on information on the customer, said information comprising his email address, in a first file; transmitting a second email including information on the business; the person introduced becoming a new customer when the person places an order; and transmitting a third mail requesting an introduction of another new customer to the second terminal when the person is regarded as an existing customer. Mullaney does not explicitly show registering the information of the existing customer to a second file upon receiving an application as an introducer; that the second email is sent to the first terminal to be transferred to a second terminal; or that the new customer information is saved as a third file upon becoming a customer. Graham et al show all steps except explicitly showing that the information is saved in second and third files. It would have been obvious to one of ordinary skill in the art to modify the method of Mullaney as taught by Graham et al in order to better enable tracking of those in the referral program and to provide more effective referrals by providing emails sent by a friend, not an unknown commercial entity. As to storing the information in second and third files respectively, it would have been an obvious matter of design choice to do so since the specification does not disclose that the particular storage locations of the information solves any particular problem or is for any specific reason, and it appears that the information storage would function equally well in either configuration.

Alternatively, as to claims 1 and 5, Mullaney shows transmitting to a first terminal of an existing customer a first email requesting an introduction of new customers, based

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on information on the customer, said information comprising his email address, in a first file; transmitting a second email including information on the business; the person introduced becoming a new customer when the person places an order; and transmitting a third mail requesting an introduction of another new customer to the second terminal when the person is regarded as an existing customer. Mullaney does not explicitly show registering the information of the existing customer to a second file upon receiving an application as an introducer; that the second email is sent to the first terminal to be transferred to a second terminal; or that the new customer information is saved as a third file upon becoming a customer. Graham et al show all steps except explicitly showing that the information is saved in second and third files. It would have been obvious to one of ordinary skill in the art to modify the method of Mullaney as taught by Graham et al in order to better enable tracking of those in the referral program and to provide more effective referrals by providing emails sent by a friend, not an unknown commercial entity. As to storing the information in second and third files respectively, it is notoriously old and well known in the art to store information different information in discreet files. It would have been obvious to one of ordinary skill in the art to further modify the method of Mullaney to do so in order to facilitate easy and logical access to the stored data.

As to claim 6, it is noted that Mullaney in view of Graham and the well known prior art shows all recited functional units, the functional units accomplishing the steps of the method of claim 1.

As to claim 2, Mullaney shows providing an incentive.

As to claim 3, Mullaney in view of Graham et al and the well known prior art show that the email address is selected from an address book of the first terminal.

As to claim 4, Mullaney in view of Graham et al do not show requiring the introduced person to provide information about the existing customer at the order step. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to require the introduced person to provide information, such as a name, of the existing customer in order to facilitate provide the incentive to the existing customer.

As to claim 10, it is noted that Mullaney in view of Graham et al and the well known prior art show all elements of the claim discussed above regarding claims 1 and 5, plus sending a plurality of emails to a plurality of different second terminals (see e.g., spaces for three referrals in Fig. 4).

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven B. McAllister

Steven B. McAllister
Primary Examiner
Art Unit 3627

STEVE B. MCALLISTER
PRIMARY EXAMINER